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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,845	12/24/2001	William H. Reeves	L-00003-004	4172

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT PAPER NUMBER

3736

DATE MAILED: 01/16/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,845

Applicant(s)

REEVES ET AL.

Examiner

Jonathan ML Foreman

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C10/5

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 – 5 and 9 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,458,606 to Cohen et al. in view of U.S. Patent Application Publication No. 2003/0083552 to Remijan et al. and further in view of U.S. Patent Application Publication No. 2002/0165467 to Rutenberg.

In reference to claims 1 – 5 and 9 – 12, Cohen et al. discloses a microendoscope (Figure 8) having a housing having an optic fiber extending therefrom (Col. 8, lines 11 – 23), the housing having a first channel to receive the optic fiber, a second channel to receive an optic light source, and a third channel. An image can be seen through the optic fiber by a camera connected to the first channel (Col. 7, lines 11 – 18). The housing is generally v-shaped. A flexible protective tubing covers the optic fiber (Col. 8, lines 41 – 44). However, Cohen et al. fails to disclose an introducer needle or the needle being equipped with a stylet. Remijan et al. discloses a microendoscope having an introducer needle with a removable stylet having a neck than can be gripped [0043] – [0045]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the microendoscope as disclosed by Cohen et al. to include an introducer needle having a stylet as taught by Remijan et al. in order to position the microendoscope within the body to view the desired location [0043]. Cohen et al. discloses removing tissue through a third channel (Col. 5,

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lines 25 – 27), but fails to disclose inserting a tissue removing member through the third channel.

Rutenberg teaches a cytological brush that passes through the operative channel in an endoscope to remove surface epithelial cells. Rutenberg teaches that the size of the brush and the structure of the brush can be varied [0044]. It would have been obvious to one having ordinary skill in the art to modify the microendoscope as disclosed by Remijan et al. to include a cytological brush as taught by Rutenberg in order to perform non-lacerational biopsies of the ovary. It is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, i.e., a functional limitation, does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). Where the prior art reference is inherently capable of performing the function described in a functional limitation, such functional limitation does not define the claimed apparatus over such prior art reference, regardless of whether the prior art reference explicitly discusses such capacity for performing the recited function. *In re Ludtke*, 441 F.2d 660, 169 USPQ 563 (CCPA 1971). In addition, where there is reason to believe that such functional limitation may be an inherent characteristic of the prior art reference, Applicant is required to prove that the subject matter shown in the prior art reference does not possess the characteristic relied upon. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986); *In re Ludtke*, 441 F.2d 664, 169 USPQ 566 (CCPA 1971).

3. Claims 6 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,458,606 to Cohen et al. in view of U.S. Patent Application Publication No. 2003/0083552 to

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Remijan et al. and further in view of U.S. Patent Application Publication No. 2002/0165467 to Rutenberg as applied to claim 5 above, and further in view of U.S. Patent No. 5,873,814 to Adair.

In reference to claims 6 – 8, Cohen et al. in view of Cohen et al. in view of Remijan et al. in view of Rutenberg discloses a camera being connected to a monitor (Col. 5, lines 1 - 5). However, Cohen et al. in view of Remijan et al. in view of Rutenberg fails to disclose the monitor being connected to a computer having software to enable viewing of the image, a touch screen monitor, and the computer including a microphone and having voice recognition software associated with the microphone to permit notes to be recorded. Adair teaches an endoscopic video touch screen monitor (Col. 4, lines 36 – 42; lines 49 – 65) and a computer having a microphone and voice recognition software associated with the microphone to permit notes to be recorded (Col. 4, lines 58 – 65; Col. 8, lines 60 – 62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the monitor and computer as disclosed by Cohen et al. in view of Remijan et al. in view of Rutenberg to be a touch screen monitor and to include a microphone and voice recognition software associated with the microphone in order to remove the need for a keyboard and allow the surgeon to control the endoscope and record data hands free.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on

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the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 4,700,694 to Shishido, U.S. Patent No. 5,083,549 to Cho et al. and U.S. Patent No. 5,156,590 to Vilmar.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703)-305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F Hindenburg can be reached on (703)308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9306 for regular communications and (703)-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0858.



JMLF
January 12, 2004



MAX F. HINDENBURG
SUPERINTENDING EXAMINER
TECHNOLOGY CENTER 3700